

REMARKS

A Petition and Fee for One Month Extension of Time is submitted herewith.

Claims 1-5 and 7-16 are presently pending in this application. Claim 1 has been amended to more particularly define the claimed invention. Claims 11-16 have been added to claim additional features of the claimed invention. Claim 6 have been canceled.

It is noted that the amendments are made only to more particularly define the invention and not for distinguishing the invention over the prior art, for narrowing the scope of the claims, or for any reason related to a statutory requirement for patentability. It is further noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Applicant gratefully acknowledges the Examiner's indication that claim 2 would be allowable if rewritten in independent form. However, Applicant submits that all of the claims are allowable.

Claim 1 is objected to due to informalities. Applicant has amended claim 1 in a manner believed fully responsive to all points raised by the Examiner.

Claims 1-5 and 7-10 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 1 has been amended in a manner believed fully responsive to all points raised by the Examiner.

Claims 1 and 7-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Admitted State of Prior Art, further in view of Sparrow, U.S. Pat. No. 3,626,545.

Claim 3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Admitted State of Prior Art and Sparrow, U.S. Pat. No. 3,626,545, further in view of Knoedler et al.,

U.S. Pat. No. 5,210,532.

Claim 4-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Admitted State of Prior Art and Sparrow, U.S. Pat. No. 3,626,545 further in view of Edwards et al., U.S. Pat. No. 6,946,988.

These rejections are respectfully traversed in view of the following discussion.

I. APPLICANT'S CLAIMED INVENTION

The claimed invention (as defined, for example, by independent claim 1) is directed to a combination of a dust collector and a hand-held power tool comprising a power cord, the dust collector including a motor functioning as a driving source, a drive unit for driving the motor, a dust collection fan rotated by the motor, and a head section for accommodating the dust collection fan. A switch is provided on the head section to control the drive unit to start and stop the motor. A tank section is located below the head section, for accommodating dust conveyed by the dust collection fan, the tank section including a connecting portion to which a duct hose including one end and an other end, the one end attached to the connecting portion, the other end being detachable from a portion of the power tool. The dust collector further includes a power cord, a remote-control transmitter for transmitting a signal, a remote-control receiver for receiving the signal from the remote-control transmitter to control the drive unit to start or stop the motor, and a receiving antenna connected to the remote-control receiver, the receiving antenna being disposed in an area where the motor has no influence. The hand-held power tool includes a power cord.

Conventionally, debris collecting vacuum systems for attachment to a power tool included the operator manually activating the vacuum before operating the power tool, and

after operating the power tool, manually deactivating the vacuum. Additionally, the power tool could be electrically connected to the vacuum such that when the power tool is activated/deactivated, the vacuum is activated/deactivated at the same time. However, this latter configuration causes too much electrical current loading of a single power supply circuit for both the power tool and the vacuum. (Application at page 1, line 10 to page 5, line 4, and Figs. 9 and 10.)

The claimed invention (e.g., as recited in claim 1), on the other hand, includes a switch provided on the head section to control the drive unit to start and stop the motor, and a remote-control receiver for receiving the signal from the remote-control transmitter to control the drive unit to start or stop the motor. These features of the claimed invention are important for providing two means for control of the dust collector by either the switch or the remote-controlled receiver wherein convenient selection may be made according to the particular details of work or users particular preference (Application at page 9, line 25 to page 10, line 21).

II. THE ALLEGED PRIOR ART REJECTIONS

A. 35 U.S.C. § 103(a) Rejection over Admitted State of Prior Art further in view of Sparrow, U.S. Pat. No. 3,626,545

The Examiner alleges that Admitted State of Prior Art, (ASPA), further in view of Sparrow, U.S. Pat. No. 3,626,545, (Sparrow), makes obvious the invention of claims 1 and 7-10.

Applicant respectfully contends, however, that ASPA further in view of Sparrow does not teach or suggest:

“a switch provided on the head section to control the drive unit to start and stop the motor,” and

“a remote-control receiver for receiving the signal from the remote-control transmitter to control the drive unit to start or stop the motor.”

The Examiner alleges that one of ordinary skill in the art would have been motivated to modify ASPA with the teaching from Sparrow to form the invention of claims 1 and 7-10. Applicant respectfully contends, however that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant respectfully contends that ASPA would not have been combined with Sparrow as alleged by the Examiner. Indeed, the Sparrow reference teaches against the ASPA by stating that conventional systems with the switches used to control a vacuum system have been replaced with a remote control that "achieves the same ends," column 2, lines 21-24. Sparrow additionally teaches the replacement of conventional switches that once activated a vacuum system with “all that is required to operate the system is a small [wireless] transmitter,” below:

The basic difference between the present system and those of the prior art resides in the fact that the present system includes a radio receiver mounted in the location of the central dust collection container, and upon receipt of a command signal will cause a vacuum generating motor in the container to start or stop operation as desired. All that is required to operate the system is a small transmitter carried by the vacuum hose operator who simply presses a button to transmit the selected type of command signal. (Emphasis added.) (Column 1, lines 55-64.)

Therefore, no person of ordinary skill in the art would have considered combining the Sparrow reference with ASPA, absent impermissible hindsight, since Sparrow teaches away from Examiner's alleged combination of ASPA and the remote wireless transmitter of Sparrow, in that Sparrow clearly discloses control of the vacuum system (at 18) with only a wireless transmitter, and excludes any non-wireless switch controlling the vacuum system.

In fact, Applicant respectfully contends that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner that teach or suggest Applicant's claimed language. There is no teaching or suggestion in Sparrow that would include both a vacuum system switch and a remote wireless transmitter to control the disclosed vacuum system (at 18).

Therefore, Applicant respectfully contends that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner.

Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references (alone or in combination) fail to teach or suggest each and every element and feature of Applicant's claimed invention.

B. 35 U.S.C. § 103(a) Rejection over Admitted State of Prior Art and Sparrow, U.S. Pat. No. 3,626,545 further in view of Knoedler et al., U.S. Pat. No. 5,210,532

The Examiner alleges that Admitted State of Prior Art and Sparrow, U.S. Pat. No. 3,626,545, (ASPA and Sparrow), further in view of Knoedler et al., U.S. Pat. No. 5,210,532, (Knoedler), makes obvious the invention of claim 3.

Applicant respectfully contends, however, that ASPA and Sparrow further in view of Knoedler does not teach or suggest, *"a switch provided on the head section to control the drive unit to start and stop the motor," and, "a remote-control receiver for receiving the signal from the remote-control transmitter to control the drive unit to start or stop the motor."*

With respect to the rejection of Applicant's claim 3, Applicant respectfully contends that Knoedler would not have been combined with ASPA and Sparrow for the reasons recited above with respect to independent claim 1, and even if combined, the combination would not

teach or suggest each and every element of the claimed invention.

Knoedler discloses a baby monitor receiver for use in combination with a transmitter unit. Therefore, Knoedler fails to overcome the deficiencies of ASPA and Sparrow, “*a switch provided on the head section to control the drive unit to start and stop the motor,*” **and**, “*a remote-control receiver for receiving the signal from the remote-control transmitter to control the drive unit to start or stop the motor.*”

Therefore, Applicant respectfully request the Examiner to reconsider and withdraw this rejection since the alleged prior art references (alone or in combination) fail to teach or suggest each and every element and feature of Applicant’s claimed invention.

C. 35 U.S.C. § 103(a) Rejection over Admitted State of Prior Art and Sparrow, U.S. Pat. No. 3,626,545 further in view of Edwards et al., U.S. Pat. No. 6,946,988

The Examiner alleges that Admitted State of Prior Art and Sparrow, U.S. Pat. No. 3,626,545, (ASPA and Sparrow), further in view of Edwards et al., U.S. Pat. No. 6,946,988, (Edwards), makes obvious the invention of claim 4-5.

Applicant respectfully contends, however, that ASPA and Sparrow further in view of Edwards does not teach or suggest, “*a switch provided on the head section to control the drive unit to start and stop the motor,*” **and**, “*a remote-control receiver for receiving the signal from the remote-control transmitter to control the drive unit to start or stop the motor.*”

With respect to the rejection of Applicant’s claims 4-5, Applicant respectfully contends that Edwards would not have been combined with ASPA and Sparrow for the reasons recited above with respect to independent claim 1, and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Edwards discloses a detachable remote controller for use on an electric entertainment device. Therefore, Edwards fails to overcome the deficiencies of ASPA and Sparrow, “a switch provided on the head section to control the drive unit to start and stop the motor,” and, “a remote-control receiver for receiving the signal from the remote-control transmitter to control the drive unit to start or stop the motor.”

Therefore, Applicant respectfully request that the Examiner to reconsider and withdraw this rejection since the alleged prior art references (alone or in combination) fail to teach or suggest each and every element and feature of Applicant’s claimed invention.

III. FORMAL MATTERS AND CONCLUSION

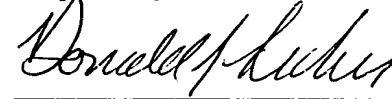
In view of the foregoing, Applicant submits that claims 1-5 and 7-16, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date: December 14, 2006

Respectfully Submitted,



Donald J. Lecher, Esq.

Reg. No. 41,933

Sean M. McGinn, Esq.

Reg. No. 34,386

McGinn Intellectual Property Law Group, PLLC
8321 Old Courthouse Rd., Suite 200
Vienna, Virginia 22182
(703) 761-4100
Customer No. 21254